

**REMARKS**

Applicants note that in response to a telephone call on December 9, 2005 from the Applicants' representative to the Examiner, the Examiner stated that the indication on page 6 that the current Office Action is a "final" Office Action is in error, and as indicated in item 2b of the Office Action Summary, the current Office Action is rather a non-final Office Action.

Claims 1, 7, and 13 are amended herein to clarify that according to an aspect of the present invention "charging said destination user is carried out without judging whether or not said packet data is the registered particular packet." Support for the amendment is found, for example, on page 9, lines 14-16 of the specification. No new matter is presented in any of the foregoing and, accordingly, approval and entry of the amended claims are respectfully requested.

Claims 1-19 are pending and under consideration.

**STATEMENT ON SUBSTANCE OF INTERVIEW**

An interview was conducted on February 27, 2006 between the Applicants' representative and the Examiner. Applicants thank the Examiner for the interview. During the interview, Applicants pointed out to the Examiner support for the claim recitation in the specification.

As discussed during the interview, further reference to "registering" is included in the present amendment. In addition, Applicants representative argued that "packets" are not discussed by the cited art.

**ITEM 3: REJECTION OF CLAIMS 1, 7, AND 13 UNDER 35 U.S.C. §112, FIRST PARAGRAPH**

In item 3 of the Action, the Examiner rejects claims 1, 7, and 13 under 35 U.S.C. §112, first paragraph and contends the recited features "without judging whether or not said packet data is the registered particular packet data," are not supported in the specification.

As discussed during the interview, Applicants respectfully submit that the feature is fully and properly supported. For example, the specification on page 3 line 20-26, for example, discusses:

the sender, who is an advertiser, (1) registers information regarding destination users and particular packet data to be sent, such as direct mail or other data including programs, and a carrier, which provides an advertisement agent service, for example, transmits the particular packet data to the destination users. A terminal of the destination user receives (2) packet data including the particular packet data (which was registered) from a mailbox, for example, as usual. At that time, the carrier (3) charges the destination user at one point as usual.

(Emphasis added.)

That is, the specification discusses that: (1) particular packet data is registered, (2) packet data that is not registered, and particular packet data that is registered, is received, and (3) initial charging is without judging distinction between packet data that is not registered and registered particular packet data.

Further, page 9, lines 14 to 16 of the specification discuss "(t)he packet switch 5 performs a processing to charge the destination user for the received packet of the mail including the advertising mail (stepS11) (emphasis added)." The advertising mail corresponds to "the registered particular packet data." Therefore, the packet switch performs a processing to charge the destination user for the normal mail and the advertising mail. That is, the packet switch performs a processing to charge the destination user for the received packet regardless of the kinds of the mail.

Further, "charging" is also discussed on pages 1-2, starting at line 18, and page 8, lines 27-28, "a number of packets of said particular packet data" in a transferring is discussed on page 12, lines 6 to 8, and "an amount of the transferred communication fee" is discussed, for example, on page 10, lines 14 to 16.

In addition, the Examiner states "the examiner would interpret said limitation as meaning charging a registered sender for a particular send packet data (emphasis added)." The Examiner's interpretation is not correct. That is, even before the amendment in contention, the claims clearly represented "charging said destination user for said packet data." Therefore, "said charging" in the wherein clause is "charging said destination user for said packet data." However, the present amendment clarifies this feature to avoid such misunderstanding.

Applicants submit that claims 1, 7, and 13, all as amended, comply with 35 U.S.C. §112, first paragraph and request withdrawal of the rejection.

**ITEM 3: REJECTION OF CLAIMS 1-3, 5-9, 11-15 AND 17-19 UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER MEURONEN (U.S. 6,473,622)**

**ITEM 4: REJECTION OF CLAIMS 4, 10, AND 16 UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER MEURONEN IN VIEW OF JACOBS (U.S. 2004/0039784)**

The Examiner rejects claims 1-3, 5-9, 11-15 and 17-19 under 35 U.S.C. §103(a) as being unpatentable over Meuronen and claims 4, 10, and 16 under 35 U.S.C. §103(a) as being unpatentable over Meuronen in view of Jacobs. The rejections are traversed.

Independent claims 1, 7, and 13, recite, respectively, a method, a computer-readable storage, and a system, using claim 1 as an example, including "registering into a transmitting information storage device, information regarding destination users, a sender, and particular packet data to be sent; when a terminal of said destination user registered in said transmitting information storage device performs a processing to receive packet data, charging said destination user for said packet data, wherein said charging said destination user is carried out without judging whether or not said packet data is the registered particular packet; and transferring the communication fee, charged to said destination users for said particular packet data, to said sender registered in said transmitting information storage device, by using a receiving status data for said particular packet

data to be received by said terminals of said destination users registered in said transmitting information storage device, wherein a number of packets of said particular packet data is calculated from said particular packet data stored in said transmitting information storage device, and an amount of the transferred communication fee is calculated by using a number of destination users specified by said receiving status data, and said number of packets of said particular packet data."

Independent claim 19 recites a method for transferring a communication fee including "charging a destination user for received packet data regardless of particular packet data received; and transferring a communication fee charged to the destination user for the particular packet data to a sender registered in a transmitting information storage device by using a receiving status data for said particular packet data to be received, wherein a number of packets of the particular packet data is calculated from the particular packet data stored in the transmitting information storage device, and an amount of the transferred communication fee is calculated by using a number of destination users specified by the receiving status data, and the number of packets of said particular packet data."

Applicants submit that the cited art, alone or in combination, does not teach features recited by the claims and thus *prima facie* obviousness is not established.

#### **Packets Not Taught By Meuronen**

As discussed during the interview, Meuronen merely teaches a short message billing system. As well-known in the art and as discussed in Meuronen (col. 4, line 66 to col. 5, line 2) "a connection-specific record TT (Toll Ticket, TT) containing sufficient information for calculating the costs of the connection is created per each connection at least when the call is terminated." That is, the short message is not billed based on a number of packets.

On the other hand, according to the present invention, the amount of the transferred communication fee is calculated by using a number of packets of particular packet data.

In item 5 of the current Action, entitled Response to Arguments, the Examiner contends the Applicants specification:

defines "packets" in page 4, paragraph 2 that packet data includes "advertisements. Meuronen teaches in column 7, lines 15-25 charging advertisers for ads (i.e. packets) sent to subscribers. Therefore, Meuronen teaches packets, as defined by Applicant's specification.

Applicants submit that the Examiner's contention and logic is not correct. Rather, the advertisements are not necessarily packet data. When ads are sent by an abort message in Meuronen, packets for the ads, for example, are not generated. That is, merely because packet data can include advertisements, does not teach that advertisements are packets.

As an example, Applicants points out that as understood in the art a packet may be defined as "a short, fixed-length section of data that is transmitted as a unit in an electronic communications

network." (See, for example, NIHnet Handbook Glossary at <http://www.cit.nih.gov/dns/handbook/Main/glossary.htm#P>).

That is, while a short, fixed-length section of data can contain data that includes advertisement data, it does not necessarily follow that an advertisement is a short, fixed-length section of data transmitted as a unit.

Since Meuronen does not discuss packets, further recited features such as relying on "particular packet data" are also not taught.

#### **Cited Art Does Not Teach Charging By Number Of Packets**

In item 5 of the current Action, the Examiner contends that Meuronen:

bills subscribers and/or advertisers for each short digital message (i.e. packet) sent to said subscribers. Therefore, in Meuronen, the more messages sent to subscribers, the more Meuronen would bill advertisers or subscribers for each additional packets sent to said subscribers. Therefore, Meuronen is charging by a number of packets sent to destination users, similar to Applicant's claimed invention.

Applicants submit that the Examiner is incorrect and that such a contention does not respond to the Applicants' argument that since transmission bit rates may be different, a billing system that charges based on a number of connections does not teach a charging based on a number of packets.

Applicants also submit that, for example, that a same number of typical dial-up connections, for example, would not enable a same packet transfer as a same number of broad-band cable connections.

A number of destination users specified by receiving status data is not taught by Meuronen. since Meuronen carries out charge processing and transfer processing per each connection.

#### **Cited Art Does Not Teach Registering**

The Examiner contends that Meuronen teaches "registering into a transmitting information storage device, information regarding (1) destination users, (2) a sender, and (3) particular packet data to be sent (emphasis added)," citing column 7, lines 13-23.

Applicants submit that the Examiner is incorrect in that Meuronen does not discuss, in the lines cited, or anywhere else such a registering of all of (1), (2), and (3).

#### **Meuronen Teaches Away From Present Invention**

According to the present invention, claim 1 for example, recites "charging said destination user is carried out without judging whether or not said packet data is the registered particular packet data." That is, the charging does not need any checking to change the processing.

In contrast, as taught in col. 6, lines 26 to 36 of Meuronen,:

the short message gateway MSC SMS-GMSC checks if the message includes a parameter indicating the price of the message. When noticing that the short message includes said parameter, the MSC creates record TT.

That is, the parameter of the message has to be checked in order to transfer fees.

In addition, the aforementioned portion in Meuronen clearly teaches "the short message gateway MSC would create record TT, on the basis of which the sender of the short message would be charged a certain unit price (emphasis added)." This indicates the primary charging destination is the "sender."

In contrast, according to an aspect of the present invention, as recited by claim 1, for example, the primary charging destination includes "the destination user of the packet data," that is, the receiver.

In addition, the Examiner cites col. 7, lines 14-24 in Meuronen as teaching "charging" as recited in claim 1, for example,. However, the aforementioned portion in Meuronen rather merely teaches that a final charging destination can be changed regardless of the primary charging destination, but there is no description that the primary charging destination can be changed. Therefore, in Meuronen, the primary charging destination must be the sender.

On the other hand, according to aspects of the present invention, the sender is charged for the registered particular packet data.

#### **Features Recited By Dependent Claims Not Taught By Cited Art**

Further, features recited by dependent claims are not taught by the cited art. For example, dependent claim 2 recites a method "charging said sender for said particular packet data when said particular packet data is transmitted to the destination users registered in said transmitting information storage device."

In support of the rejection of claim 2, the Examiner cites Meuronen col. 7, lines 13-24. However, according to the aforementioned citation, the sender is not charged. In contrast, according to an aspect of the invention as recited by claim 2, the sender is charged twice.

As another example, dependent claim 3 recites a method "registering information regarding said sender and said particular packet data to be sent into said transmitting information storage device; and registering information regarding said destination users into said transmitting information storage device." In support of the rejection of claim 3, the Examiner cites Meuronen col. 3, lines 35-42, and col. 7, lines 13-24. However, Meuronen does not teach any registration in the cited portion.

As another example, claims 4, 10, and 16 recite, using claim 4 as an example, "registering information regarding said destination users includes registering information regarding said

destination user that is acquired when a terminal of said destination user requests said particular packet data." Neither Meuronen nor Jacobs teach a billing system of transmitted data based on destination user requests of "particular packet data." Further, there is no motivation or reasonable chance of success to combine Meuronen and Jacobs as the Examiner contends since Jacobs does not teach a billing system of transmitted data.

As another example, dependent claim 6 recites a method wherein "transferring further comprises: acquiring data regarding said particular packet data which does not reach; and specifying destination users who is confirmed to have performed said processing to receive said particular packet based on said data regarding said packet which does not reach.

In support of the rejection of claim 6, the Examiner cites Meuronen col. 7, lines 13-25. However, Meuronen does teach packets and "particular packet data." Rather, Meuronen adopts the billing system based merely on a connection. Therefore, when the connection cannot be carried out, there is no charge, because the start time and end time cannot be detected.

#### **Examiner's Statements Without Support**

In support of the rejection of claims 1-3, 5-9, 11-15 and 17-19, the Examiner states "the bigger the number of messages sent by said advertisers that are relayed by an operator and received directly by said destination users, the more said advertisers (i.e. sender) would have to pay to cover the expenses of said distribution." (Action at page 5).

In support of the rejection of claims 4, 10, and 16, the Examiner states that "charging the sending party (i.e. advertiser) instead of the receiving party (i.e. destination user) in a mobile communication system would make said receiving party more willing to accept data from said sending party." (Action at page 7).

Applicants respectfully traverse the Examiner's statements and demand the Examiner produce authority for the statements. As set forth, in M.P.E.P. § 2144.03(e):

any facts so noticed should . . . serve only to 'fill in the gaps' in an insubstantial manner which might exist in the evidentiary showing made by the Examiner to support a particular ground of rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based.

In this case, the noticed facts are not considered to be common knowledge or well-known in the art. Instead, these limitations are unique to the present invention. See M.P.E.P. § 2144.03(a) ("the notice of facts beyond the record which may be taken by the Examiner must be "capable of such instant and unquestionable demonstration as to defy dispute").

In addition, if the Examiner also bases the rejection, at least in part, on personal knowledge, the Examiner is required under 37 C.F.R. § 1.104(d)(2) to support such an assertion with an

affidavit when called for by the Applicants. Thus, Applicants call upon the Examiner to support such assertions with an affidavit.

### Action Incomplete

As discussed during the interview, Applicants submit that the current Action is incomplete since the Examiner has not responded to some of the arguments in the previous Amendment filed August 31, 2005 in response to the Office Action mailed September 16, 2005. For example, in the previous Amendment, Applicants submitted that Meuronen does not teach "transferring the communication fee charged to said destination users for said particular packet data . . . of said destination users registered," in the lines cited by the Examiner or anywhere else.

That is, both the receiver and sender are charged, and a sender is only charged for the receiving fee is not taught by Meuronen. In the present Action, the Examiner merely repeats the previously cited lines.

Accordingly, Applicants respectfully submit that if the claims are not immediately found allowable, another Action should be provided that responds fully to the arguments and with the response date reset.

### Summary

Since *prima facie* obviousness is not established, the rejections should be withdrawn and claims 1-19 allowed.

### CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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